

## **REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

### **A. Status of related applications**

The Applicants wish to draw the Examiner's attention to the applicants' related co-pending applications and issued patents (see Appendix A) directed to nanoparticles and methods of preparation and use thereof.

### **B. Status of the claims**

Claims 433-436, 481-499 and 501-556 were pending in this application. Claims 511-533 was cancelled in order to expedite the prosecution of this application. Claim 556 was amended to remove dependency from cancelled claims. No new matter has been introduced into this application as a result of the present amendment. Claims 433-436, 481-499, 501-510, and 534-556 are now pending in this application.

### **C. Rejections of the claims under 35 U.S.C. section 102(e) or, alternatively, under 35 U.S.C. section 103 based on Kossovsky or Yguerabide**

Turning to the office action, the Examiner had indicated that claims 433-436, 481-499, 501-510, and 534-555 were allowed. The Examiner, however, objected to dependent claims 523-533 and 556, but indicated that these claims would be allowable if placed into independent claim format. Claims 511-514 stand rejected under 35 U.S.C. section 102(e) as being anticipated by, or in the alternative, under 35 USC section 103(a) as being obvious over Kossovsky (U.S. Patent No. 5,460,831)("Kossovsky"). Claims 511-522 also stand rejected under 35 U.S.C. section 102(e) as being anticipated by, or in the alternative, under 35 USC section 103(a) as being obvious over Yguerabide (U.S. Patent No. 6,214,560)("Yguerabide"). The Applicants respectfully submit that the rejection is moot in light of Applicants' present amendments to expedite the prosecution of this application. Withdrawal of the rejections based on Kossovsky and Yguerabide is in order and is respectfully requested.

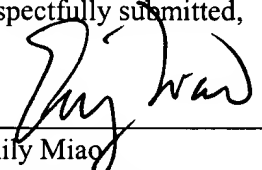
### **D. Conclusion**

In conclusion, the Applicants respectfully submit that the application is in condition for an allowance and request a Notice to this effect.

Reconsideration of this application is respectfully requested and a favorable determination is earnestly solicited. The Examiner is invited to contact the undersigned representative if the Examiner believes that this would be helpful in expediting the prosecution of this application.

Dated: Nov. 15, 2009

Respectfully submitted,

  
\_\_\_\_\_  
Emily Miao  
Reg. No. 35,285

McDonnell Boehnen  
Hulbert & Berghoff, LLP  
300 South Wacker Drive  
Chicago, IL 60606  
Telephone: 312-913-0001  
Facsimile: 312-913-0002



November 15, 2004

Page 1 of 7

**APPENDIX A**

<b>ATTY Case No.</b>	<b>Serial No./ Filing Date</b>	<b>Inventors/Title</b>	<b>Status</b>
<b>00-653-G</b>	U.S. 10/794,741 Filed 3/5/04	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton, Garamella, Li, Park/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFORE	PENDING
<b>00-713-B1</b>	09/923,625 Filed 8/7/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	U.S. Patent no. 6,773,884, issued 8/10/04
<b>00-713-C</b>	09/344,667, filed 6/25/99	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFORE	U.S. Patent No. 6,361,944, issued 3/26/02
<b>00-713-I</b>	U.S.S.N 09/603,830 Filed 6/26/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton; NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	U.S. Patent No. 6,506,564, issued 1/14/03
<b>00-713-I-1</b>	09/961,949 9/20/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton;	U.S. Patent No. 6,582,921, issued June 24, 2003

<b>ATTY Case No.</b>	<b>Serial No./ Filing Date</b>	<b>Inventors/Title</b>	<b>Status</b>
		NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	
<b>00-713-I-2</b>	09/957,318 9/20/01	See 00-713-I-1	U.S. Patent No. 6,759,199, issued 7/6/04
<b>00-713-I-3</b>	09/957,313 9/20/01	See 00-713-I-1	U.S. Patent No. 6,645,721, issued 11/11/03
<b>00-713-I-4</b>	09/966,491 9/28/01	See 00-713-I-1	U.S. Patent No. 6,610,491, issued August 26, 2003
<b>00-713-I-5</b>	09/966,312 9/28/01	See 00-713-I-1	U.S. Patent No. 6,673,548, issued January 6, 2004
<b>00-713-I-6</b>	09/967,409 9/28/01	See 00-713-I-1	U.S. Patent No. 6,740,491, issued May 24, 2004
<b>00-713-I-7</b>	09/974,500 10/10/01	See 00-713-I-1	U.S. Patent No. 6,709,825, issued March 23, 2004
<b>00-713-I-8</b>	09/974,007 10/10/01	See 00-713-I-1	PENDING
<b>00-713-I-9</b>	09/973,638 10/10/01	See 00-713-I-1	ALLOWED
<b>00-713-I-10</b>	09/973,788 10/10/01	See 00-713-I-1	U.S. Patent No. 6,720,411, issued April 13, 2004
<b>00-713-I-11</b>	09/975,062 10/11/01	See 00-713-I-1	U.S. Patent No. 6,677,122, issued January 13, 2004
<b>00-713-I-12</b>	09/975,376 10/11/01	See 00-713-I-1	PENDING
<b>00-713-I-13</b>	09/975,384 10/11/01	See 00-713-I-1	PENDING

<b>ATTY Case No.</b>	<b>Serial No./ Filing Date</b>	<b>Inventors/Title</b>	<b>Status</b>
<b>00-713-I-14</b>	09/975,498 10/11/01	See 00-713-I-1	ALLOWED
<b>00-713-I-15</b>	09/975,059 11/11/01	See 00-713-I-1	ALLOWED
<b>00-713-I-16</b>	09/976,601 10/12/01	See 00-713-I-1	ALLOWED
<b>00-713-I-17</b>	09/976,968 10/12/01	See 00-713-I-1	U.S. Patent No. 6,818,753, issued 11/16/04
<b>00-713-I-18</b>	09/976,971 10/12/01	See 00-713-I-1	U.S. Patent No. 6,682,895, issued 1/27/04
<b>00-713-I-19</b>	09/976,863 10/12/01	See 00-713-I-1	PENDING
<b>00-713-I-20</b>	09/976,577 10/12/01	See 00-713-I-1	U.S. Patent No. 6,720,147, issued April 13, 2004
<b>00-713-I-21</b>	09/976,618 10/12/01	See 00-713-I-1	U.S. Patent no. 6,812,334, issued Nov. 2, 2004
<b>00-713-I-22</b>	09/981,344 10/15/01	See 00-713-I-1	U.S. Patent No. 6,777,186, issued August 17, 2004
<b>00-713-I-23</b>	09/976,900 10/12/01	See 00-713-I-1	ALLOWED
<b>00-713-I-24</b>	09/976,617 10/12/01	See 00-713-I-1	U.S. Patent No. 6,730,269, filed May 4, 2004
<b>00-713-I-25</b>	09/976,378 10/12/01	See 00-713-I-1	PENDING
<b>00-713-i-26</b>	10/410,324 04/10/03	See 00-713-I-1	PENDING
<b>00-713-L</b>	U.S.S.N. 09/693,005	Mirkin, Letsinger, Mucic, Storhoff,	U.S. Patent No. 6,495,324, issued

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
	Filed 10/20/00	Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERE TO AND USES THEREFORE	12/17/02
00-713-M	U.S.S.N. 09/693,352 Filed 10/20/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERE TO AND USES THEREFORE	U.S. Patent No. 6,417,340, issued 7/9/02
00-714-G	U.S. 09/830,620 Filed 8/15/01	Mirkin, Nguyen/ NANOPARTICLES WITH POLYMER SHELLS	PENDING
00-715-A	U.S. 09/760,500 Filed 1/12/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton; Garamella, Li/ METHOD OF ATTACHING OLIGONUCLEOTI DES TO NANOPARTICLES AND PRODUCTS PRODUCED THEREBY	U.S. Patent No. 6,767,702, issued July 27, 2004
00-715-B	U.S. 10/716,829 Filed 11/18/03	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton; Garamella, Li/ METHOD OF ATTACHING OLIGONUCLEOTI DES TO NANOPARTICLES AND PRODUCTS PRODUCED THEREBY	Pending

<b>ATTY Case No.</b>	<b>Serial No./ Filing Date</b>	<b>Inventors/Title</b>	<b>Status</b>
<b>00-1085-A</b>	U.S.S.N. 09/820,279 Filed 3/28/01	Mirkin,Letsinger, etc./ METHOD AND MATERIALS FOR ASSAYING BIOLOGICAL MATERIALS	U.S. Patent No. 6,750,016, issued June 15, 2004
<b>00-1085-G</b>	U.S.S.N. 10/640,618 Filed 8/13/03	Mirkin,Letsinger, etc./ METHOD AND MATERIALS FOR ASSAYING BIOLOGICAL MATERIALS	Pending
<b>00-1086-A</b>	U.S. 09/903,461 Filed 7/11/01	Letsinger, Garimella/ METHOD OF DETECTION BY ENHANCEMENT OF SILVER STAINING	U.S. Patent No. 6,602,669, Filed 8/5/03
<b>00-1272-C</b>	U.S.S.N. 10/008,978 Filed 12/7/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton, Garimella, Li, Park, Lu/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERE TO AND USES THEREOF	ALLOWED
<b>01-565-A</b>	USSN 10/125,194 Filed 4/18/02	Mirkin, Nguyen, Watson, Park/ OLIGONUCLEOTI DE-MODIFIED ROMP POLYMERS AND CO- POLYMERS	PENDING
<b>01-599-A</b>	U.S.S.N. 10/291,291 Filed 11/08/02	Storhoff/NOVEL THIOL-BASED METHOD FOR ATTACHING OLIGONUCLEOTI DES TO NANOPARTICLES	PENDING
<b>01-661-A</b>	U.S.S.N.	Mirkin, Cao, Jin/	PENDING

<b>ATTY Case No.</b>	<b>Serial No./ Filing Date</b>	<b>Inventors/Title</b>	<b>Status</b>
	10/034,451 Filed 12/28/01	DNA-MODIFIED CORE-SHELL AG/AU NANOCRYSTALS	
<b>01-661-C</b>	U.S.S.N. 10/153,483 Filed 5/22/02	Mirkin, Cao, Jin/ DNA-MODIFIED CORE-SHELL AG/AU NANOCRYSTALS	PENDING
<b>01-661-E</b>	U.S.S.N. 10/397,579 3/26/03	Mirkin, Cao, Jin/ DNA-MODIFIED CORE-SHELL AG/AU NANOCRYSTALS	PENDING
<b>01-1565-A</b>	U.S.S.N. 10/266,983 Filed 10/08/02	Park, Taton, Mirkin/ARRAY- BASED ELECTRICAL DETECTION OF DNA USING NANOPARTICLE PROBES	PENDING
<b>01-1633-A</b>	U.S.S.N. 10/266,983 Filed 10/8/02	Park, Taton, Mirkin/NANOPARI CLES HAVING OLIGONUCLEOTI DES ATTACHED THERE TO AND USES THEREFOR	PENDING
<b>01-1705-A</b>	U.S.S.N. 10/108,211 Filed 3/27/02	Nam, Park, Mirkin/BIO- BARCODES BASED ON OLIGONUCLEOTI DE-MODIFIED NANOPARTICLES	PENDING
<b>02-338-B</b>	USSN 10/172,428 Filed 6/14/02	Cao, Jin, Nam, Mirkin/MULTIHA NNEL DETECTION USING NANOPARTICLE PROBES WITH RAMAN SPECTROSCOPIC	PENDING



<b>ATTY Case No.</b>	<b>Serial No./ Filing Date</b>	<b>Inventors/Title</b>	<b>Status</b>
		FINGERPRINTS	
<b>02-338-C</b>	10/431,341 5/7/03	Cao, Jin, Nam, Mirkin/MULTICHANNEL DETECTION USING NANOPARTICLE PROBES WITH RAMAN SPECTROSCOPIC FINGERPRINTS	PENDING
<b>02-1227-A</b>	10/735,357 Filed 12/12/03	DIRECT SNP DETECTION WITH UNAMPLIFIED NUCLEIC ACID USING NANOPARTICLE PROBES	PENDING
<b>03-214-A</b>	10/789,831 Filed 2/27/04	LABEL-FREE GENE EXPRESSION PROFILING WITH UNIVERSAL NANOPARTICLE PROBES IN MICROARRAY ASSAY FORMAT	PENDING
<b>03-466-C</b>	10/854,848 Filed 5/27/04	METHOD FOR DETECTING ANALYTES BASED ON EVANESCENT ILLUMINATION AND SCATTER- BASED DETECTION OF NANOPARTICLE PROBE COMPLEXES	PENDING
<b>03-666-E</b>	10/877,750 Filed 6/25/04	BIOBARCODE	PENDING